



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*CB*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/430,943	11/01/99	NAUNHEIMER	H 4100-178

THOMAS C PONTANI ESQ  
COHEN PONTANI LIEBERMAN & PAVANE  
551 FIFTH AVENUE SUITE 1210  
NEW YORK NY 10176

PM92/0207

EXAMINER

PANG, R

ART UNIT

PAPER NUMBER

3681

DATE MAILED: 02/07/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/430,943

Applicant(s)  
Naunheimer et al.

Examiner  
Roger Pang

Group Art Unit  
3681



☒ Responsive to communication(s) filed on Jan 12, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-7 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-3, 6, and 7 is/are rejected.

☒ Claim(s) 4 and 5 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 3681

### **DETAILED ACTION**

The following action is in response to communications filed for application 09/430,943 on January 12, 2001.

#### ***Election/Restriction***

1. Applicant's election without traverse of Species 1 and 2 in Paper No. 5 is acknowledged.

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the two gear stages and one of said plurality of clutches arranged inside the rotor (in claim 6) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

#### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: applicant must incorporate the limitations of claims 3 and 6 into the specification.

Art Unit: 3681

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. An embodiment where two gear stages are located in an interior of the motor is never disclosed (see claim 6). Also, applicant is reminded that Species 1 was elected, and an enabled embodiment with the limitations of claim 6, would have to be withdrawn from consideration.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hewko.

With regard to claim 1, Hewko teaches a drive for vehicles comprising a plurality of components including: an electric traction motor 44 having a rotor; at least one variable speed mechanical gear

Art Unit: 3681

stage 31 connected to said rotor and having an output ; and at least one brake 58 connected to the output of the at least one variable speed mechanical gear stage; wherein one of said at least one gear stag 49 and said at least one brake are arranged inside the rotor of the electric motor and the other of said gear stage and said brake 58 are arranged laterally outside the electric motor so as to be arranged coaxially therewith and in substantially the same plane as the others of said plural components which are arranged outside the electric motor (Fig. 1). With regard to claim 2, Hewko teaches the drive, wherein said electric traction motor further comprises one of an internal 132 and external rotor. With regard to claim 3, Hewko teaches the drive, wherein said electric traction motor is operable to allow brief operation close to a motor cut-off output (Col. 3, lines 19-26). With regard to claim 7, Hewko teaches the drive, wherein said at least one brake 58 is arranged proximate a radial outer side of said drive and comprises a radial outer diameter which is approximately the same as a radial outer diameter of said motor.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hewko. Hewko teaches the drive wherein said at least one brake 58 is arranged proximate a radial outer side of

Art Unit: 3681

said drive and comprises a radial outer diameter which is approximately the same as a radial outer diameter of said motor. However, if it is believed Hewko does not teach this, it would have been obvious to modify Hewko to employ a brake comprising a radial outer diameter which is approximately the same as a radial outer diameter of said motor, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Note: the limitation of "A drive for track laying vehicles" in the preamble has been ignored, since it is a statement of intended use.

#### *Allowable Subject Matter*

10. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sonobe has been cited to show a similar transmission with an external rotor.

Kawamoto, Iijima, Moroto, Chikamori, Morikawa, Klemen, and Taniguchi have been cited to show similar transmissions.

Art Unit: 3681

### **FACSIMILE TRANSMISSION**

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-3597. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Art Unit: 3681

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on \_\_\_\_\_ (Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

\_\_\_\_\_

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.




Art Unit: 3681

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roger Pang whose telephone number is (703) 305-0445. The examiner can normally be reached on weekdays (Monday through Thursday) from 6:30 a.m to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, can be reached at (703) 308-0830. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

  
RLP

February 1, 2001

  
**CHARLES A. MARMOR**  
**SUPERVISORY PATENT EXAMINER**  
**ART UNIT 3681**